

Patents

McKool Smith lawyer secures Fed Circuit win in decade-long case

Rani Mehta September 12, 2024



Josh Budwin, principal at the firm, said the case was one of the most complex technology disputes he's ever worked on

Learning the technology was one of the greatest challenges facing a McKool Smith principal who won a precedential victory at the Court of Appeals for the Federal Circuit after a decade-long dispute.

The Federal Circuit issued an [opinion](#) in favour of ParkerVision against Qualcomm on September 6.

In doing so, the appellate court vacated a summary judgment from the District Court for the Middle District of Florida, which had found that Qualcomm hadn't infringed ParkerVision's patent.

The Federal Circuit also reversed the district court's decision to exclude the testimony of ParkerVision's validity and exclusion experts. It remanded the case for further proceedings at the Florida court consistent with its opinion.

The McKool Smith team included principals Josh Budwin, Kevin Burgess, Joel Thollander, Matthew Cameron, and Mitch Verboncoeur.

Budwin told Managing IP that the technology was very complicated.

"It was probably one of the most, if not the most, complex cases I've ever worked on from a technology perspective," he said.

He added that the case history was also complicated, given how long it has been pending.

ParkerVision had sued Qualcomm in 2014. The case had been delayed in part because there was a stay pending the resolution of an inter partes review and US International Trade Commission proceedings.

But because he had been advising his client so long, he had become familiar with the technology.

"They have a genius inventor, David Sorrells. He's very personable and is a great person to explain the specifics of the technology. He's self-taught, and so he's more approachable in his teaching."

Oral arguments

The firm had to take this complicated case history into account when preparing for oral arguments, noted Budwin.

"We had to come back up to speed on things that we'd been familiar with five or six years ago and that we needed to have at our fingertips," he said.

He added that he also worked with experienced appellate advocates at the firm and tried to get people who weren't familiar with the case to review the record and come up with some complicated questions.

"You're standing at a podium in an ornate room with three judges looking down and when they ask you a question, you better have the correct answer at your fingertips. If you don't, it could be a problem."

Budwin added that he's excited to be able to wrap up this case.

"We're excited to go back to the district court and finally get some resolution after more than ten years."

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